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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,843	08/24/2001	Victor Spoke III	TREM.0001	1221

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REED SMITH LLP
3110 FAIRVIEW PARK DRIVE, SUITE 1400
FALLS CHURCH, VA 22042

EXAMINER	
FISHER, MICHAEL J	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/935,843	SOPKO ET AL.	
	Examiner	Art Unit	
	Michael J Fisher	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PAT 6,125,312 to Nguyen et al. (Nguyen).

As to claims 1,9 and 10, Nguyen discloses a system for providing maintenance service information (title) that includes providing a warranty on long-term equipment (while not specifically discussed, it would be inherent in that warranty information and compliance is discussed, as in claims 5-10), which warranty inherently transfers the risk of maintaining performance of the equipment as, if the equipment fails to function (does not maintain performance) and if the failure falls under the warranty the warranty provider assumes responsibility for repairs, developing a maintenance schedule (col 2, paragraph 2), maintaining the equipment according to the schedule (col 2, paragraph 3).

Nguyen further discloses diagnosing the equipment to ensure that it is up to specifications (fig 1).

Nguyen does not, however, teach a third party as being the warrantor, repairing the equipment to achieve a standard. It is well known in the art for insurance companies to inspect items placed under insurance. For instance, if someone insures a used-vehicle with full coverage insurance, including collision insurance, it is well-known that the insurance company will inspect the vehicle so as to ensure that they will not be required to pay for pre-existing problems with the vehicle. Further, if equipment is purchased, it is well known for that equipment to meet certain standards (such as required inspection items for aircraft that is in place to ensure that the airplanes used meet minimum safety requirements), therefore, it would have been obvious to one of ordinary skill in the art to ensure that the aircraft of Nguyen meet minimum requirements, and further, to bring the plane up to those minimum requirements, to ensure safe flying of the airplane. The requirements would be negotiated by the parties (the owner of the aircraft would agree or disagree to do so, this would be 'negotiating'.)

It is further very well known in the art for there to be a third-party as warrantor. Therefore, it would have been obvious to one of ordinary skill in the art to use a third-party warrantor so the manufacturer would not be burdened with warranty costs.

As to claim 2, as the airplane is being inspected, it would be inspected where it is located.

As to claim 3, it would be obvious to talk to at least one owner or manager to ensure that the maintenance schedule will be followed.

As to claim 4, Nguyen discloses generating a report on results of the diagnosing step (20).

As to claim 5, Nguyen further discloses analyzing the results of the diagnosing step (24).

As to claim 6, Nguyen further discloses providing recommendations for repairs and cost estimates (30).

As to claim 7, it would be obvious to one of ordinary skill in the art to modify the maintenance schedule if the performed inspections show a need for a different maintenance schedule.

As to claim 8, Nguyen discloses inputting results of the inspection step (20).

As to claims 11-16, warranties differ according to cost. Therefore, it would have been obvious to one of ordinary skill in the art to provide a warranty that covers 100% of the cost of ownership at a premium price and further, to provide a warranty that excludes certain willful or unforeseen occurrences.

Response to Arguments

Applicant's arguments filed 10/04/04 have been fully considered but they are not persuasive. As the arguments in relation to the 'third-party provider', these have been discussed in the above rejection. The provider would inherently have the responsibility of repairing warrantied items. As is discussed above, business dealing inherently have negotiations involved. Whether or not to use the service would be considered to be negotiations. As to arguments about "buyer" v "existing owner", in response to

applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. already owned items) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). There is no limitation in the claims that could be read to exclude new purchases or to only include previously purchased items. As to arguments related to repairs, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., on-demand v. routine) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Fisher whose telephone number is 703-306-5993. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF
2/7/05

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600